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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,891	06/14/2005	Raymond Seltzer	HC/1-22816/ACGC 2135/PCT	5156
324	7590	10/21/2008	EXAMINER	
JoAnn Villamizar			DEES, NIKKI H	
Ciba Corporation/Patent Department			ART UNIT	
540 White Plains Road			PAPER NUMBER	
P.O. Box 2005			1794	
Tarrytown, NY 10591			MAIL DATE	
			DELIVERY MODE	
			10/21/2008	
			PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/538,891

**Applicant(s)**

SELTZER ET AL

**Examiner**

Nikki H. Dees

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 11, 2008, has been entered.
2. Claims 1-4 and 14-17 are currently pending in the application. Claims 19 and 20 have been cancelled. The previous objections to claims 19 and 20 have been withdrawn in view of the cancellation of claims 19 and 20.

### ***Election/Restrictions***

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Group I: butylated hydroxytoluene;

Group II: benzylphosphonates, phosphites and phosphonites; and

Group III: esters of b-(3,5-di-tert-butyl-4-hydroxyphenyl)propionic acid with mono- or polyhydric alcohols, esters of b-(5-tert-butyl-4-hydroxy-3-

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methylphenyl)propionic acid with mono- or polyhydric alcohols, esters of b-(3,5-dicyclohexyl-4-hydroxyphenyl)propionic acid with mono- or polyhydric alcohols, and esters of 3,5-di-tert-butyl-4-hydroxyphenyl acetic acid with mono- or polyhydric alcohols.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1-4 and 14-16.

4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the antioxidants of claim 17 are from separate and distinct classes of antioxidants.
5. During a telephone conversation with Tyler Stevenson on October 3, 2008, a provisional election was made without traverse to prosecute the invention of butylated hydroxytoluene.

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6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

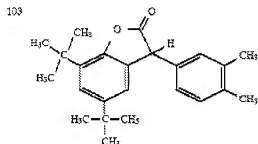
***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesvadba (5,814,692) in view of Griffith et al. (2,768,084) and Codex Standard 19 (Codex Standard for Edible Fats and Oils not Covered by Individual Standards. 1999. Codex Alimentarius).

9. Nesvadba teaches 3-arylbenzofuranones including the compound shown below



10. Additional examples of related compounds are shown in Table 1 of Nesvadba.

Nesvadba states that the compounds are suitable for stabilizing organic materials against oxidative degradation (col. 25 lines 19-21). Examples of materials that are suitable to be stabilized include naturally occurring organic materials such as animal and vegetable fats, oils and waxes (col. 29 lines 16-23).

11. Nesvadba further teaches that the compounds are to be added to the materials where degradation is to be retarded in amounts preferably ranging from 0.01 to 2% by weight (col. 28 lines 43-46). Nesvadba teaches that the compounds of his invention may be provided in combination with antioxidants including tocopherols (col. 29 item 1.4) and esters of 3,5-di-tert-butyl-4-hydroxyphenyl acetic acid with mono- or polyhydric alcohols (col. 30 item 1.16).

12. Nesvadba is silent as to the organic materials being a foodstuff as claimed in claim 1, or containing fatty acid glycerides, edible fats or fatty oils, as well as the organic substance being a pet food or animal feed.

13. Griffith et al. teach an antioxidant for stabilizing foodstuffs including mayonnaise, margarine, sausage and cheese spread, or any food product containing a large amount of fatty material subject to rancidity. They state that it is well-known that rancidity

results primarily from products formed by oxidation (col. 1 lines 22-37). The foodstuffs of Griffin et al. are known to contain edible fats, fatty acid glycerides and fatty oils.

14. Griffith et al. specifically speak to the antioxidants butylated hydroxyanisol (BHA), ascorbic acid and tocopherols for use in his invention. Griffith et al. are silent as to the use of butylated hydroxytoluene (BHT) as an antioxidant in their invention.

15. Codex Stan. 19 teaches antioxidants suitable for use in edible fats and oils, which includes fatty acid glycerides. Antioxidants include BHT, BHA, gallates, and tocopherols (p. 2, 3.4).

16. As Nesvadba teaches an antioxidant compound for use with animal and vegetable fats, oils and waxes, Griffith et al. teach antioxidants for use in foodstuffs containing animal and vegetable fats and oils and Codex Stan. 19 teaches a number of antioxidants for use in fats and oils, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the antioxidant as taught by Nesvadba for use as the antioxidant in the foodstuffs as taught by Griffith et al. and Codex Stan. 19. The use of the antioxidant as taught by Nesvadba in the foodstuffs would have yielded the predictable result of retarding oxidative degradation in any foodstuff, pet food, or animal feed containing fats and oils normally susceptible to oxidative degradation. "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

***Response to Arguments***

17. Applicant's arguments filed August 11, 2008, with respect to claims 1-4 and 14-17 have been considered but they are not persuasive.

18. Applicant argues (Remarks, p. 10) that the combination of Nesvadba and Griffin does not meet the limitations of the instant claims.

19. One of ordinary skill in the art at the time the invention was made, taking into account the disclosure of Nesvadba wherein the claimed compound is disclosed as an antioxidant for use with animal and vegetable fats, oils and waxes, could have clearly envisaged the antioxidants for use in foodstuffs, as is claimed in the instant invention. Antioxidants are well-known to be used in combination with fatty foodstuffs, as is taught by Griffith et al. and Codex Stan. 19, and one of ordinary skill in the art would have found it obvious to add a compound known as an antioxidant in order to function in an antioxidative capacity. The addition of an antioxidant to a fatty foodstuff would not have required undue experimentation, and there would have been a reasonable expectation that the antioxidant would function effectively in the fatty foodstuff.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nikki H. Dees  
Examiner  
Art Unit 1794

/Carol Chaney/  
Supervisory Patent Examiner, Art Unit 1794